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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,615	06/28/2001	Brian M. Hillier	9-16085-1US	4904
20988	7590	12/01/2006	EXAMINER	
OGILVY RENAULT LLP 1981 MCGILL COLLEGE AVENUE SUITE 1600 MONTREAL, QC H3A2Y3 CANADA			BOVEJA, NAMRATA	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 12/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/892,615	HILLIER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 June 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/28/01</u>  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Claims 1-16 are presented for examination.

### Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

2. Claims 9 and 16 are rejected under 35 U.S.C. 112, second paragraph, since the recitation "method is effected in real time," renders the claim indefinite, because it is unclear what the Applicant means by this statement. It is interpreted to mean that method takes place in real time. Appropriate correction is required.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-16 are rejected under 102(a) as being anticipated by Kalina (Patent Number 5,970,480 hereinafter Kalina).

In reference to claim 1, Kalina teaches an electronic purchasing method using redeemable points, comprising the steps of: providing a customer card

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having user information program thereon (col. 2 lines 13-18 and col. 4 lines 5-19); providing a customer card reader for a merchant at a point of purchase for reading said user information (col. 4 lines 5-19), said reader being networked with a plurality of readers (col. 4 lines 21-37); providing a central register having user information stored therein and connected to said network for access of said information (col. 4 lines 32-37 and col. 4 lines 59-col. 5 lines 5); providing bank information of said merchant accessible by information transmitted from said central register (col. 4 lines 32 to col. 5 lines 13 and Figure 1-1); purchasing a good or service (col. 4 lines 62 to col. 5 lines 2); crediting or debiting a user with non-cash redeemable points (col. 4 lines 5-31 and col. 4 lines 59 to col. 5 lines 13); forwarding debit or credit information to said central register through said reader (col. 4 lines 16-20 and 59-62); and simultaneously debiting a merchant in cash a predetermined percentage of the taxed value of said purchase (i.e. a fee) (col. 4 lines 37-50).

4. In reference to claim 2, Kalina teaches the electronic purchasing method, further including the step of entering a password (i.e. pin) at said reader of allowing a user to access users information (col. 3 lines 44-46 and col. 4 lines 16-17).

5. In reference to claim 3, Kalina teaches the electronic purchasing method further including the step of storing credit and debit information of said user in said central register (col. 4 lines 21-31, col. 4 lines 59 to col. 5 lines 13).

6. In reference to claim 4, Kalina teaches the electronic purchasing method, further including the step of determining the currency of a transaction (i.e. a credit

award to cash conversion value) (col. 4 lines 67 to col. 5 lines 15).

7. In reference to claim 5, Kalina teaches the electronic purchasing method, further including the step of printing a receipt (i.e. a periodic statement) of a transaction (col. 5 lines 5-13).

8. In reference to claim 6, Kalina teaches the electronic purchasing method further including the step of altering an amount of points attributed to a customer for a purchase by said merchant (i.e. points are credited based on the amount of purchase and therefore they vary with the purchase amount) (col. 4 lines 27-31).

9. In reference to claim 7, Kalina teaches the electronic purchasing method further including the step of providing a customer with an option to purchase a good or service with cash or accrued points (i.e. customer always has an option to purchase an investment vehicle with cash without the use of accrued points and customer has to sign off an a directive to purchase the investment vehicle with credits) (col. 4 lines 51 to col. 5 lines 2).

10. In reference to claim 8, Kalina teaches the electronic purchasing method, wherein said accrued points are exhausted in entirety for purchasing a good or service (i.e. when the award points reach a preassigned level, they are converted to a cash value used to purchase investment vehicles) (col. 4 lines 59 to col. 5 lines 2).

11. **Disclaimer:** Claim 9 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 9, Kalina teaches the electronic purchasing method,

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wherein said method is effected in real time (i.e. the method takes place in real time) (col. 4 lines 16 to col. 5 lines 5).

12. In reference to claim 10, Kalina teaches the electronic purchasing method, wherein accrued points are immediately available from said central register for use by said customer subsequent to a purchase (col. 4 lines 16-31).

13. In reference to claim 11, Kalina teaches the electronic purchasing method, wherein said central register comprises a database (i.e. user data is stored and matched in memory) (col. 3 lines 50-56 and col. 4 lines 21-31).

14. In reference to claim 12, Kalina teaches the electronic purchasing method, wherein said network comprises the internet (i.e. information is exchanged between networked computer systems of the merchant and the bank) (col. 4 lines 16-37).

15. In reference to claim 13, Kalina teaches an electronic purchasing method using redeemable points, comprising the steps of: providing a customer card having user information program thereon (col. 2 lines 13-18 and col. 4 lines 5-19); providing a merchant at a point of purchase with means for conveying said user information over a network to a central register (col. 4 lines 5-19); providing a central register having user information stored therein and connected to said network for access of said information (col. 4 lines 32-37 and col. 4 lines 59-col. 5 lines 5); providing bank information of said merchant accessible by information transmitted from said central register (col. 4 lines 32 to col. 5 lines 13 and Figure 1-1); purchasing a good or service (col. 4 lines 62 to col. 5 lines 2); crediting or debiting a user with non-cash redeemable points (col. 4 lines 5-31 and col. 4

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lines 59 to col. 5 lines 13); forwarding debit or credit information to said central register through said means for conveying said user information (col. 4 lines 16-20 and 59-62); simultaneously debiting a merchant in cash a predetermined percentage of the taxed value of said purchase (i.e. a fee) (col. 4 lines 37-50); and simultaneously crediting a customer with a predetermined amount of said non-cash redeemable points (col. 4 lines 21-31).

16. In reference to claim 14, Kalina teaches the electronic purchasing method, wherein said non-cash redeemable points are immediately available for use by a customer for purchase of a good or service.

17. In reference to claim 15, Kalina teaches the electronic purchasing method, further including the step of providing a customer with an option to purchase said good or service with cash or said non-cash redeemable points (col. 4 lines 16-31).

18. **Disclaimer:** Claim 16 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 16, Kalina teaches the electronic purchasing method, wherein said method is effected on the internet in real time (i.e. the method takes place in real time) (col. 4 lines 16 to col. 5 lines 5).

***Point of Contact***

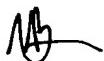
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone

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number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

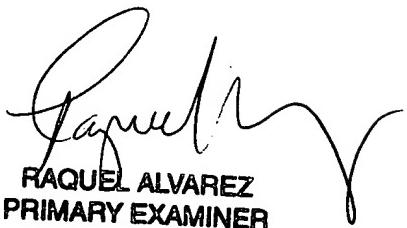
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

November 26<sup>th</sup>, 2006



RAQUEL ALVAREZ  
PRIMARY EXAMINER